REMARKS

Claims 1-12, and 14-39 are pending, with claims 1, 12, 24, 29, 25 and 35 being the independent claims. No new matter has been added. Reconsideration of the application, in view of the following remarks, is respectfully requested.

Applicant has prepared and submitted concurrently herewith a Supplemental IDS based on receipt of a Foreign Office Action dated September 6, 2005. Entry and consideration of the IDS, and a notice to that effect is requested.

In the Office Action dated July 27, 2005, independent claims 1, 12, 24 and 29, and dependent claims 2-5, 10, 11, 14-17, 22-23, 25-28 and 30-34 were rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,636,733 ("*Helferich '733*"), while claims 6-9 and 18-21 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Helferich '733* in view of U.S. Patent No. 6,289,223 ("*Mukherjee*"). For the following reasons, reconsideration and withdrawal of the rejections are respectfully requested.

The Office Action (pg. 2, ¶2) states:

> Helferich discloses a method for delivering messages in a network comprising at least one terminal device (Fig. 1; col. 3, lines 22-33; col. 5, lines 15-20), comprising: generating a message; setting a condition for receiving said message; deciding whether said message is to be received by a terminal device based on said condition; and transmitting said message to said terminal device based on whether the message is to be received (col. 9, line 25 - col. 10, line 30).

With respect to the foregoing statement, the following is noted. *Helferich '733* has a U.S. filing date of May 24, 2000, which is subsequent to the October 8, 1999 filing date of PCT/EP99/07563 to which the present application is entitled to claim priority. Therefore, the filing date of *Helferich '733* is subsequent to the filing date of the present application, which is October 8, 1999. However, *Helferich '733* was a continuation-in-part application of serial number 09/408,841 filed on September 30, 1999 (now U.S. Patent No. 6,826,407) that claimed priority to provisional application 60/155,055 filed on September 30, 1999 and provisional application 60/126,939 filed March 29, 1999.

Helferich '733 was also a continuation-in-part application of application serial number 08/934,143 filed September 19, 1997 (now U.S. Patent No. 6,233,430), application serial number 08/933,344 filed September 19, 1997 (now U.S. Patent No. 6,253,061), application serial number 08/934,132 filed September 19, 1997 (now U.S. Patent No. 6,087,956), application serial number

08/934,337 filed September 19, 1997 (now U.S. Patent No. 6,259,892) and application serial number 08/989,874 filed December 12, 1997 (now U.S. Patent No. 6,097,941).

In order for the subject matter of the *Helferich* '733 patent to be entitled to either the September 19, 1997, December 12, 1997, March 29, 1999 or September 30, 1999 filing dates, the relevant subject matter must have been described in any of the originally filed applications.

Applicant has reviewed the disclosure of provisional applications 60/155,055 and 60/126,939, and both of these provisional applications fail to include the relevant portion of *Helferich* '733 cited by the Examiner, i.e., col. 9, line 25 - col. 10, line 30. That is, the 60/126,939 and 60/155,055 *Helferich* provisional applications fail to teach the subject matter relied upon in the Office Action to reject Applicant's claims, i.e., generating a message, setting a condition for receiving [the] message, deciding whether [the] message is to be received by a terminal device based on the condition, and transmitting the message to [the] terminal device based on [the] result of the deciding step.

Moreover, Applicant has reviewed U.S. Patent Nos. 6,233,430, 6,253,061, 6,087,956, 6,259,892 and 6,097,941, and all of them fail to disclose the subject matter relied upon in the Office Action to reject Applicant's claims. Hence, the subject matter used to reject Applicant's claims was added in the continuation-in-part application filed on May 24, 2000, which is subsequent to the priority date of the present application. Therefore, this subject matter is only entitled to the May 24, 2000 actual filing date of the application for the '733 patent. Consequently, *Helferich* '733 fails to qualify as prior art with respect to the steps of "generating a message; setting a condition for receiving said message; deciding whether said message is to be received by a terminal device based on said condition; and transmitting said message to said terminal device based on whether the message is to be received, since the filing date of the present application, i.e., October 8, 1999, is prior to the May 24, 2000 actual filing date of the *Helferich* '733 patent. Therefore, *Helferich* '733 fails to anticipate independent claim 1 and thus, withdrawal of the rejection under 35 U.S.C. §102(e) is in order and a notice to that effect is respectfully solicited.

Mukherjee relates to a system and method that enables the transmission of SMS messages to select multipoint addressees from a single point of origination (see col. 1, line 66 thru col. 2, line1). *Mukherjee* also fails to teach or suggest the present claimed invention, since *Mukherjee* fails to teach or suggest the steps of "setting a condition for receiving [a] message, deciding whether [the] message is to be received by a terminal device based on the condition, and transmitting the message to [the] terminal device based on [the] result of the deciding step," as

recited in independent claim 1. In view of the foregoing, independent method claim 1 is patentable over *Mukherjee*, either individually or in combination with *Helferich*. Consequently, reconsideration and withdrawal of all the rejections under 35 U.S.C. §102 and 35 U.S.C. §103 are in order, and a notice to that effect is requested.

Independent claims 12, 24 and 29 are system and device claims associated with the implementation of independent method claim 1. Accordingly, independent system and device claims 12, 24 and 29 are patentable for the reasons discussed above with respect to the combination of *Helferich* and *Mukherjee*.

Claims 35-39 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Helferich* '733 in view of U.S. Patent No. 6,289,223 ("*Mukherjee*").

As stated previously, the subject matter used to reject Applicant's claims was added in a continuation-in-part application filed on May 24, 2000, which is subsequent to the priority date of the present application. Therefore, this subject matter is only entitled to the May 24, 2000 actual filing date of the application for *Helferich* '733. Consequently, *Helferich* '733 fails to qualify as prior art with respect to the claimed steps and *Mukherjee* fails to provide what *Helferich* '733 lacks. Claim 35 is therefore patentable over the combination of *Helferich* '733 and *Mukherjee* due to the failure of the combined references to teach a device in which the step of "setting a condition for receiving [a] message, deciding whether [the] message is to be received by a terminal device based on the condition, and transmitting the message to [the] terminal device based on [the] result of the deciding step" is performed.

In view of the patentability of independent claim 1, 12, 24, 29 and 35, for the reasons set forth above, dependent claims 2-11, 14-23, 30-34 and 38-39 are also patentable over the cited prior art.

Based on the foregoing amendments and remarks, this application should be in condition for allowance. Early passage of this case to issue is requested.

Respectfully submitted,
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